BASIS FOR THE AMENDMENT

Claims 24-46 are active in the present application. Claims 1-23 are canceled without prejudice or disclaimer of subject matter. Claims 24-26 correspond with previously presented Claims 14, 15 and 17, respectively. Support for the new claims is found in the previously presented claims.

REQUEST FOR RECONSIDERATION

The Advisory Action of November 22, 2005, included a rejection of some of the claims under obviousness-type double patenting in view of U.S. Patent No. 6,455,455 (Deller). In the Office Action of May 4, 2005, the Office supported the rejection on the following grounds:

> Although the conflicting claims are not identical, they are not patentably distinct from each other as a whole because both the instant application and the patent claim an aqueous dispersion containing Si-Al-oxide with similar compositions and properties that were made by similar process and a process for polishing, while the instant application differs from the patent wherein it recites a limitation of Si-O-Al bonds and a dispersion using particular energy input. (See page 10 of the Office Action of May 4, 2005).

Present independent Claim 24 is drawn to a process for producing an aqueous dispersion. The process includes dispersing a certain silicon-aluminum oxide with high shear and wherein the energy input is at least 200 KJ/m^3. Present Claim 26 corresponds to original Claim 7 and recites a specific surface area for the powder (e.g., between 5 and 300 m^2/g).

As Applicants argued in the Amendment filed in the present case on October 4, 2005, the art of record in the present case does not disclose a process that includes dispersing carried out with the energy input recited in Claim 27 (e.g., previous Claim 14). If the art of record (e.g., U.S. Patent No. 6,455,455 and co-pending U.S. Application No. 10/354,969) does not disclose or suggest this feature of the invention, then the art of record cannot render the claimed invention obvious. Applicants submit that on its face this is sufficient basis to withdraw any obviousness or obviousness-type double patenting rejections (i.e., under the meaning 35 U.S.C. §103) that were raised against the previously pending claims in view of U.S. Patent No. 6,455,455 and U.S. Application No. 10/354,969.

Applicants respectfully request that the Office acknowledge that none of presently pending Claims 24-26 are obvious in view of the disclosure of U.S. 6,455,455 or the claims of co-pending 10/354,969.

Independent Claim 27 is drawn to an aqueous dispersion "having been produced by dispersing the silicon-aluminum mixed oxide in an aqueous medium with an energy input of at 200 KJ/m^3." Deller nowhere discloses or claims an aqueous dispersion that is produced with an energy input of at least 200 KJ/m^3. Applicants thus submit that the rejection of the present claims under obviousness-type double patenting in view of Deller is not supportable and should be withdrawn.

Applicants request the Office acknowledge that the present claims are not obvious in view of the claims of Deller, notwithstanding the Terminal Disclaimer filed in the present case on October 4, 2005.

Not only does Deller not disclose the production of an aqueous dispersion with an energy input of at least 200 KJ/m^3, the Office has already withdrawn rejections of the present claims in view of EP 1048617 (EP '617) which is a publication of a foreign application corresponding to Deller. Applicants submit that the Office should now acknowledge that the present claims are not obvious in view of the claims of Deller because the Office separately determined that the claimed invention is patentable over EP '617. For example, the Office stated the following in the Reasons for Allowance of the Notice of Allowance of December 20, 2005:

> Claims 7 and 14-15 are allowed over the arguments by the Applicants in the prior art of record that neither teaches nor fairly suggests a process of making an aqueous dispersion of the silicon-aluminum mixed-oxide compositions employing high shear with an energy input of at least 200 KJ/m^3. Although presence of such an energy input could have been inherent in the prior art processes, such inherency could not be established with absolute certainty. (See page 3 of the Notice of Allowance).

Thus, the Office is requested to acknowledge that the rejection of the claims of the present applications under obviousness-type double patenting in view of the claims of Deller should be withdrawn.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Stefan U. Koschmieder, Ph.D.
Registration No. 50,238

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)